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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) PALM.0863							
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)], or is being facsimile transmitted to the USPTO on <u>June 13, 2006</u> Signature <u><i>Tom Shea</i></u> Typed or printed name <u>Tom Shea</u>		<table border="1" style="width:100%; border-collapse: collapse;"> <tr> <td style="width:50%; padding: 5px;">Application Number 09/932,213</td> <td style="width:50%; padding: 5px;">Filed August 17, 2001</td> </tr> <tr> <td colspan="2" style="padding: 5px;">First Named Inventor William WEBB et al.</td> </tr> <tr> <td style="padding: 5px;">Art Unit 2675</td> <td style="padding: 5px;">Examiner CHANG, Kent Wu</td> </tr> </table>		Application Number 09/932,213	Filed August 17, 2001	First Named Inventor William WEBB et al.		Art Unit 2675	Examiner CHANG, Kent Wu
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<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal. Attached herewith.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table style="width:100%;"> <tr> <td style="width:50%; vertical-align: top;"> <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>42,828</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____ </td> <td style="width:50%; vertical-align: top; padding-left: 20px;"> <u>/Zurvan Mahamedi/</u> Signature <u>Zurvan Mahamedi Reg. No. 42,828</u> Typed or printed name <u>408-236-6640</u> Telephone number <u>June 13, 2006</u> Date </td> </tr> </table> <p><small>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.</small></p>				<input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>42,828</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	<u>/Zurvan Mahamedi/</u> Signature <u>Zurvan Mahamedi Reg. No. 42,828</u> Typed or printed name <u>408-236-6640</u> Telephone number <u>June 13, 2006</u> Date				
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<input type="checkbox"/> Total of _____ forms are submitted.									

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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U.S. Patent Application No. 09/932,213

Group Art Unit: 2673

Filed: August 17, 2001

Title: A MOBILE DEVICE HAVING MOVEABLE SEGMENTS THAT CAN BE
ADJUSTED TO AFFECT AN OVERALL LENGTH (As Amended)

Confirmation No: 5012

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In response to the Final Office Action dated March 13, 2006, please consider the following Pre-Appeal Brief Request for Review.

Under recent guidelines, the U.S. Patent Office permits a request for pre-appeal conference in cases where the Applicant believes there has been "the examiner's omissions of one or more essential elements needed for a prima facie rejection." In this case, Applicant believes that the Final Office Action dated March 13, 2006 had omissions of essential elements which failed to create a proper prima facie rejection under obviousness.

Claims 1-50 stand rejected under 35 U.S.C. Section 103(a) as being unpatentable over Boesen (U.S. Patent No. 6,542,721, "Boesen"). Applicant requests reconsideration of this rejection for the following reason.

Claim 1 is representative of the other claims in this Application. Claim 1 (and its dependents thereof) requires **"a second segment moveably coupled to the first segment to move primarily *along one axis without pivoting*, between a contracted position and an extended position, wherein an overall length of the mobile device is maximized when the second segment is in the extended position..."** ("Claim Feature") The Office

Action dated March 13, 2006 has no indication of a teaching in any reference as to aspects of the Claim Feature. Absent a teaching, no prima facie case for an obviousness rejection can be made.

Boesen simply does not teach the Claim Feature. The Claim Feature requires that the second segment move along one axis, and not pivot, when moving into an extended position that maximizes an overall length of the mobile device. In Boesen, one segment must pivot when moved into a position that maximizes the overall length of the device. Even if one was to assume the Examiner was correct in stating that Boesen allows some unidirectional movement, Boesen does not teach unidirectional movement to place one housing segment in a position where the overall length is maximized.

To be clear, Applicant's argument is not that Boesen segment's must always pivot when moved (albeit it is Applicant's position that there is always some pivot in the movement). Rather, the Claim Feature recites movement required from one housing segment to obtain the position where the overall length of the device is maximized. In Boesen, one segment must pivot in order to move into a position where the overall length of the device is maximized. As such, Boesen does not teach the Claim Feature.

The Office Action does not point out or provide any teaching in the cited art for the Claim Feature. The Examiner does not even take Official Notice. Rather than point to a prior art teaching, the Office Action generalizes the recited feature as being "an omission of an element." Citing In re KARLSON (CCPA) 136 USPQ 184 (1963), the Office Action states: "Omission of element and its function in combination is obvious expedient if remaining elements perform same functions as before."

The reasoning of Karlson is not applicable here. First, the Claim Feature is not equivalent to a pivot and slide mechanism with an omitted pivot, as argued by the Examiner. Merely omitting “pivot” from “pivot and slide” in Boesen would not provide a teaching of one housing segment that can move into a position where the overall length is maximized without pivot, and where the housing segment moves primarily along one axis. Moreover, the Examiner’s reasoning fails the test of Karlson because Karlson requires the “remaining elements perform the same functions as before [omission of the element]” in order for the rejection to be proper. Removing the elements that enable the pivot in Boesen would be akin to decoupling the housing segments of Boesen. There are no remaining elements in Boesen that correspond to a coupling mechanism that enables movement between the two housing segments to be primarily along one axis, let alone a coupling that precludes pivot.

With regard to independent claims Claim 19, 27, 41, and 45, and their respective dependent claims, Applicant notes that in addition to reciting “a second segment slideably coupled to the first segment to move, without pivoting, between a contracted position and an extended position”, the claim feature further recites “wherein an overall length of the mobile device is (i) maximized when the second segment is in the extended position, and (ii) minimized when the second segment is in the contracted position”. In addition to arguments presented above, Boesen does not teach the aspect of enabling the housing segments to move without pivoting between a first position where the overall length of the device is minimized and a second position where the overall length of the device is maximized. Even if Examiner’s arguments were true that there is non-rotational motion in Boesen, the motion does not enable movement of the housing segments

primarily along one direction and between respective positions for maximizing and minimizing the overall length of the housing.

With this submission, Applicant is, pursuant to guidelines for the pre-appeal conference, putting forth arguments that are clear from the record of the prosecution history. As such, the remarks presented herein should not be construed as admission that there are no other points of distinction between claims presented and the prior art.

For all of the reasons cited above, Applicant requests reconsideration of the rejections on record, as well as an indication of allowable claims. The Patent Office is authorized to charge all unpaid fees to the deposit account 50-1914.

Sincerely,

/Zurvan Mahamedi/

Zurvan Mahamedi Reg. No. 42,828

June 13, 2006